

REMARKS

Applicants have cancelled claims 2-10, 12, 14-16, 21 and 23 without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter encompassed by all cancelled claims in one or more continuing applications. Claims 25-117 are hereby added. No new matter has been added.

Upon entry of the present amendment, claims 1, 11, 13, 17-20, 22 and 24-117 will be pending.

I. Support for New Claims 25-117

New claims 25-117 find support in the claims as originally filed and throughout the specification. Specifically, support for new claims 25-117 can be found, for example, at pages 157-159, the last line in Table 1 on page 174, line 14 on page 201 through line 18 on page 202, line 4 on page 207 through line 2 on page 209, lines 14-18 on page 206, and lines 5-9 on page 226. Accordingly, no new matter has been added by way of amendment, and entry of the above amendment is therefore respectfully solicited.

II. The Restriction Requirement

Pursuant to Paper No. 02262004 mailed March 1, 2004, the Examiner has required an election under 35 U.S.C. § 121 of one of 605 groups. The Examiner contends that the inventions are distinct each from the other.

In order to be fully responsive, Applicants provisionally elect, *with traverse*, the invention of Group 162, represented by original claim 13 and new claims 25-117, drawn to antibodies against the polypeptide of SEQ ID NO:114 and clone ID HUVDJ43 (Gene No. 48), for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Applicants point out that claims 2-10, 12, 14-16, 21 and 23 have been canceled without prejudice or disclaimer, and that new claims 25-117 are directed to subject matter falling within the ambit of Group 162 as cast by the Examiner.

With respect to the Examiner's division of the inventions related to Gene No. 48 into 11 groups (i.e., Groups 52, 106, 162, 217, 272, 327, 382, 437, 492, 547 and

602) and the reasons stated therefore, Applicants respectfully traverse. Applicants submit that even where two patentably distinct inventions appear in a single application, restriction remains improper unless it can be shown that the search and examination of both groups would entail a “serious burden” (*See* M.P.E.P. § 803). In the present situation, no such showing has been made.

Even assuming, *arguendo*, that Groups 52, 106, 162, 217, 272, 327, 382, 437, 492, 547 and 602 represent distinct or independent inventions, Applicants submit that to search and examine the subject matter of all the Groups together would not be a serious burden on the Examiner. For example, a search of the polypeptide claims would clearly provide useful information for the antibody claims. In many, if not most publications, where a published polypeptide is described, the authors also include, as a matter of routine, an antibody that binds this polypeptide. Thus, the searches for polypeptides and antibodies that bind those polypeptides commonly overlap. Even if a publication containing a polypeptide sequence did not identify an antibody generated against that polypeptide, it is routine for one to determine shared linear epitopes between the polypeptide being searched and other polypeptides in the art and thus, antibodies that may bind the polypeptide. Thus, the search and examination of both a polypeptide and antibodies that bind that polypeptide would not entail a serious burden. Furthermore, a search of the polynucleotide claims would provide useful information for the claims in other related groups. For example, a search of HUVDJ43 polynucleotides would inherently provide relevant information for HUVDJ43 polypeptides and antibodies. Therefore, since a search of the claims of Group 106 would overlap with a search of Groups 52 and 162 *at the very least*, a search encompassing the subject matter of Groups 106, 52 and 162 together would not impose a serious burden.

Accordingly, in view of M.P.E.P. § 803, Applicants respectfully submit that, at the very least, the claims encompassing subject matter related to the polypeptide of SEQ ID NO:114 should be grouped together. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn, and that the claims encompassed by Groups 52, 106, 162, 217, 272, 327, 382, 437, 492, 547 and 602 (each relating to the polypeptide of SEQ ID NO:114) be examined together.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Entry of the above amendment is respectfully solicited. In view of the foregoing remarks, Applicants believe that this application is now in condition for allowance, and an early notice to that effect is urged. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

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Respectfully submitted,


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